

REMARKS

Claims 1-25 and 27-51 remain in the application for consideration. In view of the following remarks, Applicant traverses the Office's rejections and respectfully requests that the application be forwarded on to issuance.

§103 Rejections

Claims 1-25 and 27-51 stand rejected under 35 U.S.C. §103(a) as being obvious in view of U.S. Patent No. 6,269,195 to Gonsalves et al. (hereinafter "Gonsalves").

Applicant respectfully submits that the outstanding rejections under 35 U.S.C. §103(a) fail to establish a *prima facie* case of obviousness. Further, in accordance with MPEP §2142 (which states in part "[i]f the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness"), Applicant, in good faith and belief that a *prima facie* case of obviousness has not been established in the above of rejections, requests that all outstanding rejections under 35 U.S.C. §103(a) be reconsidered and withdrawn.

As set forth in MPEP §§2142 and 2143, a *prima facie* case of obviousness has three basic requirements. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. In addition, a modification proposed by the Office cannot render the reference unsatisfactory for its intended purpose. Further, the

1 modification proposed by the Office cannot change a principle of operation of a
2 reference. Specifically, MPEP §2143.01 entitled "Suggestion or Motivation To
3 Modify the References" instructs as follows.

4 THE PROPOSED MODIFICATION CANNOT RENDER THE
5 PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE

6 If proposed modification would render the prior art invention being
7 modified unsatisfactory for its intended purpose, then there is no suggestion
8 or motivation to make the proposed modification. In re Gordon, 733 F.2d
9 900, 221 USPQ 1125 (Fed. Cir. 1984) (Claimed device was a blood filter
10 assembly for use during medical procedures wherein both the inlet and
11 outlet for the blood were located at the bottom end of the filter assembly,
12 and wherein a gas vent was present at the top of the filter assembly. The
13 prior art reference taught a liquid strainer for removing dirt and water from
14 gasoline and other light oils wherein the inlet and outlet were at the top of
15 the device, and wherein a pet-cock (stopcock) was located at the bottom of
16 the device for periodically removing the collected dirt and water. The
17 reference further taught that the separation is assisted by gravity. The Board
18 concluded the claims were prima facie obvious, reasoning that it would
19 have been obvious to turn the reference device upside down. The court
20 reversed, finding that if the prior art device was turned upside down it
21 would be inoperable for its intended purpose because the gasoline to be
22 filtered would be trapped at the top, the water and heavier oils sought to be
23 separated would flow out of the outlet instead of the purified gasoline, and
24 the screen would become clogged.).

25 "Although statements limiting the function or capability of a prior art
device require fair consideration, simplicity of the prior art is rarely a
characteristic that weighs against obviousness of a more complicated device
with added function." In re Dance, 160 F.3d 1339, 1344, 48 USPQ2d 1635,
1638 (Fed. Cir. 1998) (Court held that claimed catheter for removing
obstruction in blood vessels would have been obvious in view of a first
reference which taught all of the claimed elements except for a "means for
recovering fluid and debris" in combination with a second reference
describing a catheter including that means. The court agreed that the first
reference, which stressed simplicity of structure and taught emulsification
of the debris, did not teach away from the addition of a channel for the
recovery of the debris.).

THE PROPOSED MODIFICATION CANNOT CHANGE THE
PRINCIPLE OF OPERATION OF A REFERENCE

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.). MPEP § 2143.01

Before undertaking a discussion of the substance of the Office's rejections, the following discussion of Applicant's disclosure and the reference to Gonsalves is provided in an attempt to assist the Office in appreciating certain distinctions between the claimed subject matter and Gonsalves.

Applicant's Disclosure

Transitions from one video to another can be implemented in different ways. One popular way of implementing a transition is through the use of a bitmap and in particular, a gray scale bit map. Other types of bits maps however, e.g. color bit maps, can be used. Typically, gray scale bitmaps, used for transitions, are individually designed by a human designer with the aid of a software application. The use of a gray scale bit map *allows one video to visually replace another video in often times creative ways.*

1 Fig. 40 shows an exemplary gray scale bit map generally at 4000 and a
2 display 4002 that contains two videos 4004 and 4006 that are in the midst of a
3 transition called a "*wipe*". In the illustrated wipe effect, video 4006 constitutes
4 the old video and video 4004 constitutes the new video. A boundary line 4008 can
5 be seen between the two videos and is moving to the right. As the boundary line
6 moves to the right, more and more of video 4004 replaces video 4006. To effect
7 this transition, bit map 4000 is used in the following way.

8 Bit map 4000 includes a large number of pixels, e.g. 300x300 or 90,000
9 pixels. Each pixel is capable of having a value which is one of a predetermined
10 number of gray scale values which represent shades of gray. For example, in this
11 case, assume that there are 256 shades of gray, each ranging in value from 0
12 (black) to 255 (white). Pixels at the far left of bitmap 4000 have gray scale values
13 that are lower than pixels at the far right of the illustrated bitmap. A programmatic
14 loop is defined such as that illustrated below:

15 For $Z = 0$ to 255,
16 Walk the picture
17 If (color < Z) show the new video, else show the old video
18

19 What this loop does is that it walks through the bitmap for each frame of
20 video. If pixel values in the bitmap are less than Z for a given frame, the new
21 video is shown. If the pixel values for a given frame are greater than Z , then the
22 old video is shown. In the Fig. 40 example, on the first pass (for the first frame),
23 $Z=0$. Since no pixels are less than 0, the new video is not shown. As Z gets
24 incremented and one proceeds through the bitmap, the new video slides in from
25

1 the left. Algorithms such as this can be used to implement hundreds of different
2 kinds of effects and transitions, just by changing the bitmap.

3 As an example of another type of transition that can be implemented using
4 gray scale bit maps, consider Fig. 41. There, a bitmap 4100 in the form of a dark
5 star in the middle, with lighter and lighter stars surrounding the dark star is shown.
6 When this bitmap is used to effect a transition between videos, a small star
7 emerges from the middle of the display and grows in time so that the new video
8 replaces the old video. For example, in display 4102, a new video 4104 is shown
9 replacing old video 4106 and is emerging through a star wipe that is provided by
10 bitmap 4100.

11 12 The Gonsalves Reference

13 Gonsalves does not deal with nor concern itself with transitions from one
14 video to another. Rather, Gonsalves pertains to forming a *composite image* from
15 first and second images. The composite image retains aspects of each of the first
16 and second images. Thus, to this extent, there is *no transition* whatsoever as that
17 term is utilized in the claims and the specification.

18 An appreciation of Gonsalves begins with its Fig. 1 and the related
19 discussion in the specification. Specifically, Gonsalves describes what is known
20 as "feathering", which is a special effect that blurs one or more portions of a video
21 image to create a composite video image from a foreground image and a
22 background image. Gonsalves instructs that a graphics editor typically feathers
23 the border between the images to blend the images together to create an effect that
24 the two images are truly one image. For example, a composite image including a
25 foreground image of two people walking and a background image of a desert

1 scene, when feathered, provides an appearance of the two people walking in the
2 desert.

3 Fig. 1 illustrates images that are manipulated to form a composite image.
4 Gonsalves instructs that the graphics editor takes a foreground image 24 from a
5 first image 20, and a background image 26 from a second image 28, and combines
6 them using a matte image 32 to form a composite image 38. The matte image is a
7 gray scale image used to generate the composite image 38. In particular, as
8 Gonsalves instructs, the light area of the matte image indicates that the area 24 of
9 the first image 20 is to be used as the foreground image, and that the area 22 is to
10 be ignored. Similarly, the dark area 36 of the matte image indicates that the area
11 26 of the second image 28 is to be the used as the background image.

12 Before generating the composite image 38, the graphics editor modifies the
13 matte image so that the graphics workstation generates a feathering effect between
14 the foreground and background images 24 and 26. In particular, the border area
15 between the light and dark area of the matte image is filtered. If the matte image
16 uses a gray scale that ranges between 0 and 255, the dark area for the background
17 is 0, the light area for the foreground is 255, and the border area between the dark
18 area and light area has values between 0 and 255 depending on the type of filtering
19 applied to the matte image. The degree of realism in the composite image 38 often
20 depends on the type of filtering. When filtering is poor, the viewer may identify a
21 border 36 between the foreground image and the background image so that the
22 effect of interaction between objects in the two images is diminished or lost.

23 Gonsalves goes on to describe an approach that allegedly improves upon
24 past feathering approaches. Gonsalves approach involves filtering and processing
25 an original matte image in a particular way to provide a so-called box-filtered

1 processed matte image. This box-filtered processed matte image is then used to
2 create the composite image.

3 4 The Claim Rejections

5 **Claim 1** recites a software-implemented video rendering system
6 comprising:

- 7 • a video application configured to enable a user to combine multiple
8 different video clips; and
- 9 • a bitmap processor operatively coupled with the video application
10 and configured to receive a first bitmap that can be used to render a
11 transition between video clips and automatically process the first
12 bitmap to provide a different transition between video clips, wherein
13 the first bitmap does not comprise video clip content, *and wherein*
14 *the transitions are configured to enable one video clip to*
15 *completely replace another video clip.*

16 In making out the rejection of this claim, the Office acknowledges that
17 Gonsalves fails to clearly teach that the transitions are configured to enable one
18 video clip to completely replace another video clip. Applicant agrees that
19 Gonsalves neither discloses nor suggests any such subject matter. Furthermore,
20 Gonsalves teaches directly away from the recited subject matter by disclosing a
21 system that feathers a first and second image to create a *composite image*. The
22 *composite image* contains features from *both* the first and the second image (see,
23 e.g. Fig. 1 and the related discussion).

24 The Office mistakenly likens Gonsalves' ability to *combine* multiple
25 different video clips to the recited subject matter which recites transitions that are
configured to enable one video clip to completely replace another video clip.

1 Applicant respectfully submits that Gonsalves neither discloses nor suggests any
2 such thing.

3 The Office argues that one of skill in the art would be motivated to modify
4 Gonsalves in this regard to provide a transition effect for displaying a complete
5 background image, whenever desired. Yet, this is completely contrary to the
6 disclosure and teaching of Gonsalves. Modifying Gonsalves in the manner
7 suggested by the Office would appear to render Gonsalves unsatisfactory for its
8 intended purpose which is to *combine* two images to create one composite image
9 where the two images appear as though they are truly one image, as well as change
10 an important operating principle of Gonsalves. As noted in the MPEP section
11 discussed above, if the proposed modification would render the prior art invention
12 being modified unsatisfactory for its intended purpose, then there is no suggestion
13 or motivation to make the proposed modification. It appears clear to Applicant, in
14 view of the §103 standard and the guidance provided by the MPEP, which is
15 firmly rooted in established case law, that there is no support for modifying
16 Gonsalves in the manner suggested by the Office.

17 Accordingly, for at least these reasons, this claim is allowable.

18 Claims 2-11 stand rejected under § 103 over Gonsalves. However, given
19 the allowability of claim 1 over Gonsalves as discussed above, claims 2-11 are
20 allowable as depending from an allowable base claim. These claims are also
21 allowable for their own recited features which, in combination with those recited
22 in claim 12, are neither disclosed nor suggested in the references of record, either
23 singly or in combination with one another.

24 Claim 12 recites a method of displaying a video comprising:
25

- 1 • selecting a bitmap that defines a first transition that can be used to transition between video clips;
- 2 • operating upon the bitmap to provide a second transition that is different from the first transition by using one or more parameters that are provided by a user, the parameters being used to operate upon the bitmap; and
- 3 • effecting the second transition between video clips, *wherein said effecting comprises completely replacing one video clip with another video clip.*

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5
6
7 In making out the rejection of this claim, the Office acknowledges that
8 Gonsalves fails to clearly teach that the transitions are configured to enable one
9 video clip to completely replace another video clip. Applicant agrees that
10 Gonsalves neither discloses nor suggests any such subject matter. Furthermore,
11 Gonsalves teaches directly away from the recited subject matter by disclosing a
12 system that feathers a first and second image to create a *composite image*. The
13 *composite image* contains features from *both* the first and the second image (see,
14 e.g. Fig. 1 and the related discussion).

15 The Office mistakenly likens Gonsalves' ability to *combine* multiple
16 different video clips to the recited subject matter which recites transitions that are
17 configured to enable one video clip to completely replace another video clip.
18 Applicant respectfully submits that Gonsalves neither discloses nor suggests any
19 such thing.

20 The Office argues that one of skill in the art would be motivated to modify
21 Gonsalves in this regard to provide a transition effect for displaying a complete
22 background image, whenever desired. Yet, this is completely contrary to the
23 disclosure and teaching of Gonsalves. Modifying Gonsalves in the manner
24 suggested by the Office would appear to render Gonsalves unsatisfactory for its
25

1 intended purpose which is to *combine* two images to create one composite image
2 where the two images appear as though they are truly one image, as well as change
3 an important operating principle of Gonsalves. As noted in the MPEP section
4 discussed above, if the proposed modification would render the prior art invention
5 being modified unsatisfactory for its intended purpose, then there is no suggestion
6 or motivation to make the proposed modification. It appears clear to Applicant, in
7 view of the §103 standard and the guidance provided by the MPEP, which is
8 firmly rooted in established case law, that there is no support for modifying
9 Gonsalves in the manner suggested by the Office.

10 Accordingly, for at least these reasons, this claim is allowable.

11 **Claims 13-22** stand rejected under §103 over Gonsalves. However, given
12 the allowability of claim 12, these claims are allowable as depending from an
13 allowable base claim. These claims are also allowable for their own recited
14 features which, in combination with those recited in claim 12, are neither disclosed
15 nor suggested in the references of record, either singly or in combination with one
16 another.

17 **Claim 23** recites a method of displaying a multi-media editing project
18 comprising:

- 19
- 20 • receiving one or more parameters from a user, the parameters being
21 associated with a multi-media editing project and relating to a
22 transition that can be applied between two video clips in the project;
 - 23 • selecting a bitmap that defines a first transition that can be used to
24 transition between the video clips;
 - 25 • operating upon the bitmap to provide a second transition that is
different from the first transition by using the one or more
parameters; and

- effecting the second transition between video clips, *wherein said effecting comprises completely replacing one video clip with another video clip.*

In making out the rejection of this claim, the Office acknowledges that Gonsalves fails to clearly teach that the transitions are configured to enable one video clip to completely replace another video clip. Applicant agrees that Gonsalves neither discloses nor suggests any such subject matter. Furthermore, Gonsalves teaches directly away from the recited subject matter by disclosing a system that feathers a first and second image to create a *composite image*. The *composite image* contains features from *both* the first and the second image (see, e.g. Fig. 1 and the related discussion).

The Office mistakenly likens Gonsalves' ability to *combine* multiple different video clips to the recited subject matter which recites transitions that are configured to enable one video clip to completely replace another video clip. Applicant respectfully submits that Gonsalves neither discloses nor suggests any such thing.

The Office argues that one of skill in the art would be motivated to modify Gonsalves in this regard to provide a transition effect for displaying a complete background image, whenever desired. Yet, this is completely contrary to the disclosure and teaching of Gonsalves. Modifying Gonsalves in the manner suggested by the Office would appear to render Gonsalves unsatisfactory for its intended purpose which is to *combine* two images to create one composite image where the two images appear as though they are truly one image, as well as change an important operating principle of Gonsalves. As noted in the MPEP section discussed above, if the proposed modification would render the prior art invention

1 being modified unsatisfactory for its intended purpose, then there is no suggestion
2 or motivation to make the proposed modification. It appears clear to Applicant, in
3 view of the §103 standard and the guidance provided by the MPEP, which is
4 firmly rooted in established case law, that there is no support for modifying
5 Gonsalves in the manner suggested by the Office.

6 Accordingly, for at least these reasons, this claim is allowable.

7 **Claims 24 and 25** stand rejected under §103 over Gonsalves. However,
8 given the allowability of claim 23, these claims are allowable as depending from
9 an allowable base claim. These claims are also allowable for their own recited
10 features which, in combination with those recited in claim 23, are neither disclosed
11 nor suggested in the references of record, either singly or in combination with one
12 another.

13 **Claim 27** recites one or more computer-readable media having computer-
14 readable instructions thereon which, when executed by a computer, cause the
15 computer to:

- 16
- 17 • select a first bitmap that defines a transition that can be applied
between two video clips in a video editing project;
 - 18 • operate upon the first bitmap to provide a second bitmap that is
different from the first bitmap by using one or more parameters that
19 are provided by a user, the first bitmap being operated upon by
operations comprising one or more of the following operations:
20 stretching, shrinking, replicating, and offsetting; and
 - 21 • use the second bitmap in a transition between at least two videos,
wherein said transition completely replaces one video with another
22 *video.*
- 23

24 In making out the rejection of this claim, the Office acknowledges that
25 Gonsalves fails to clearly teach that the transitions are configured to enable one

1 video clip to completely replace another video clip. Applicant agrees that
2 Gonsalves neither discloses nor suggests any such subject matter. Furthermore,
3 Gonsalves teaches directly away from the recited subject matter by disclosing a
4 system that feathers a first and second image to create a *composite image*. The
5 *composite image* contains features from *both* the first and the second image (see,
6 e.g. Fig. 1 and the related discussion).

7 The Office mistakenly likens Gonsalves' ability to *combine* multiple
8 different video clips to the recited subject matter which recites transitions that are
9 configured to enable one video clip to completely replace another video clip.
10 Applicant respectfully submits that Gonsalves neither discloses nor suggests any
11 such thing.

12 The Office argues that one of skill in the art would be motivated to modify
13 Gonsalves in this regard to provide a transition effect for displaying a complete
14 background image, whenever desired. Yet, this is completely contrary to the
15 disclosure and teaching of Gonsalves. Modifying Gonsalves in the manner
16 suggested by the Office would appear to render Gonsalves unsatisfactory for its
17 intended purpose which is to *combine* two images to create one composite image
18 where the two images appear as though they are truly one image, as well as change
19 an important operating principle of Gonsalves. As noted in the MPEP section
20 discussed above, if the proposed modification would render the prior art invention
21 being modified unsatisfactory for its intended purpose, then there is no suggestion
22 or motivation to make the proposed modification. It appears clear to Applicant, in
23 view of the §103 standard and the guidance provided by the MPEP, which is
24 firmly rooted in established case law, that there is no support for modifying
25 Gonsalves in the manner suggested by the Office.

1 Accordingly, for at least these reasons, this claim is allowable.

2 **Claim 28** recites a software-implemented method of displaying a multi-
3 media editing project comprising:

- 4 • providing a user interface (UI) through which a user can enter one or
5 more parameters that can be used to manipulate a bitmap-defined
6 transition;
- 7 • receiving one or more parameters that are entered by a user via the
8 UI;
- 9 • selecting a first bitmap that defines a transition and is associated
10 with the one or more parameters entered by the user;
- 11 • automatically operating upon the first bitmap to provide a second
12 bitmap that defines a transition that is different from the transition
13 defined by the first bitmap by using the one or more parameters that
14 are provided by a user, said operating comprising performing one or
15 more of the following operations on the first bitmap: stretching,
16 shrinking, replicating, and offsetting; and
- 17 • using the second bitmap in a transition between at least two videos,
18 *wherein said transition completely replaces one video with another*
19 *video.*

20 In making out the rejection of this claim, the Office acknowledges that
21 Gonsalves fails to clearly teach that the transitions are configured to enable one
22 video clip to completely replace another video clip. Applicant agrees that
23 Gonsalves neither discloses nor suggests any such subject matter. Furthermore,
24 Gonsalves teaches directly away from the recited subject matter by disclosing a
25 system that feathers a first and second image to create a *composite image*. The
composite image contains features from *both* the first and the second image (see,
e.g. Fig. 1 and the related discussion).

The Office mistakenly likens Gonsalves' ability to *combine* multiple
different video clips to the recited subject matter which recites transitions that are
configured to enable one video clip to completely replace another video clip.

1 Applicant respectfully submits that Gonsalves neither discloses nor suggests any
2 such thing.

3 The Office argues that one of skill in the art would be motivated to modify
4 Gonsalves in this regard to provide a transition effect for displaying a complete
5 background image, whenever desired. Yet, this is completely contrary to the
6 disclosure and teaching of Gonsalves. Modifying Gonsalves in the manner
7 suggested by the Office would appear to render Gonsalves unsatisfactory for its
8 intended purpose which is to *combine* two images to create one composite image
9 where the two images appear as though they are truly one image, as well as change
10 an important operating principle of Gonsalves. As noted in the MPEP section
11 discussed above, if the proposed modification would render the prior art invention
12 being modified unsatisfactory for its intended purpose, then there is no suggestion
13 or motivation to make the proposed modification. It appears clear to Applicant, in
14 view of the §103 standard and the guidance provided by the MPEP, which is
15 firmly rooted in established case law, that there is no support for modifying
16 Gonsalves in the manner suggested by the Office.

17 Accordingly, for at least these reasons, this claim is allowable.

18 **Claim 29** stands rejected under §103 over Gonsalves. However, given the
19 allowability of claim 28, these claims are allowable as depending from an
20 allowable base claim. These claims are also allowable for their own recited
21 features which, in combination with those recited in claim 28, are neither disclosed
22 nor suggested in the references of record, either singly or in combination with one
23 another.
24
25

1 **Claim 30** recites a multi-media project editing system comprising [added
2 language appears in bold italics]:

- 3
- 4 • a software implemented bitmap processor configured for use in
5 connection with a multi-media editing application to effect a
6 transition between different videos, the bitmap processor being
7 configured to:
 - 8 ○ receive one or more parameters from a user;
 - 9 ○ select a first bitmap that defines a first transition between two
10 videos;
 - 11 ○ operate upon the first bitmap in accordance with the one or
12 more parameters to provide a second transition that is
13 different from the first transition; and
 - 14 ○ apply the second transition between two videos, *wherein said
15 second transition completely replaces one video with
16 another video.*

17 In making out the rejection of this claim, the Office acknowledges that
18 Gonsalves fails to clearly teach that the transitions are configured to enable one
19 video clip to completely replace another video clip. Applicant agrees that
20 Gonsalves neither discloses nor suggests any such subject matter. Furthermore,
21 Gonsalves teaches directly away from the recited subject matter by disclosing a
22 system that feathers a first and second image to create a *composite image*. The
23 *composite image* contains features from *both* the first and the second image (see,
24 e.g. Fig. 1 and the related discussion).

25 The Office mistakenly likens Gonsalves' ability to *combine* multiple
different video clips to the recited subject matter which recites transitions that are
configured to enable one video clip to completely replace another video clip.
Applicant respectfully submits that Gonsalves neither discloses nor suggests any
such thing.

1 The Office argues that one of skill in the art would be motivated to modify
2 Gonsalves in this regard to provide a transition effect for displaying a complete
3 background image, whenever desired. Yet, this is completely contrary to the
4 disclosure and teaching of Gonsalves. Modifying Gonsalves in the manner
5 suggested by the Office would appear to render Gonsalves unsatisfactory for its
6 intended purpose which is to *combine* two images to create one composite image
7 where the two images appear as though they are truly one image, as well as change
8 an important operating principle of Gonsalves. As noted in the MPEP section
9 discussed above, if the proposed modification would render the prior art invention
10 being modified unsatisfactory for its intended purpose, then there is no suggestion
11 or motivation to make the proposed modification. It appears clear to Applicant, in
12 view of the §103 standard and the guidance provided by the MPEP, which is
13 firmly rooted in established case law, that there is no support for modifying
14 Gonsalves in the manner suggested by the Office.

15 Accordingly, for at least these reasons, this claim is allowable.

16 **Claims 31-38** stand rejected under §103 over Gonsalves. However, given
17 the allowability of claim 30, these claims are allowable as depending from an
18 allowable base claim. These claims are also allowable for their own recited
19 features which, in combination with those recited in claim 30, are neither disclosed
20 nor suggested in the references of record, either singly or in combination with one
21 another.

22 **Claim 39** recites a method of displaying a multi-media editing project
23 comprising:

- 24
- 25 • selecting a first bitmap comprising multiple pixels, each pixel being
capable of having one of a number of predetermined of gray scale

values, the first bitmap defining a transition between two videos in a multi-media editing project;

- operating upon the selected first bitmap to provide a second bitmap that is different from the first bitmap by using one or more parameters that are provided by a user, the second bit map defining a different transition;
- rescaling the second bitmap to ensure that pixels of the second bit map have, collectively, all of the predetermined gray scale values; and
- using the second bitmap in a transition between at least two videos, *wherein said transition completely replaces one video with another video.*

In making out the rejection of this claim, the Office acknowledges that Gonsalves fails to clearly teach that the transitions are configured to enable one video clip to completely replace another video clip. Applicant agrees that Gonsalves neither discloses nor suggests any such subject matter. Furthermore, Gonsalves teaches directly away from the recited subject matter by disclosing a system that feathers a first and second image to create a *composite image*. The *composite image* contains features from *both* the first and the second image (see, e.g. Fig. 1 and the related discussion).

The Office mistakenly likens Gonsalves' ability to *combine* multiple different video clips to the recited subject matter which recites transitions that are configured to enable one video clip to completely replace another video clip. Applicant respectfully submits that Gonsalves neither discloses nor suggests any such thing.

The Office argues that one of skill in the art would be motivated to modify Gonsalves in this regard to provide a transition effect for displaying a complete background image, whenever desired. Yet, this is completely contrary to the disclosure and teaching of Gonsalves. Modifying Gonsalves in the manner

1 suggested by the Office would appear to render Gonsalves unsatisfactory for its
2 intended purpose which is to *combine* two images to create one composite image
3 where the two images appear as though they are truly one image, as well as change
4 an important operating principle of Gonsalves. As noted in the MPEP section
5 discussed above, if the proposed modification would render the prior art invention
6 being modified unsatisfactory for its intended purpose, then there is no suggestion
7 or motivation to make the proposed modification. It appears clear to Applicant, in
8 view of the §103 standard and the guidance provided by the MPEP, which is
9 firmly rooted in established case law, that there is no support for modifying
10 Gonsalves in the manner suggested by the Office.

11 Accordingly, for at least these reasons, this claim is allowable.

12 **Claims 40-48** stand rejected under §103 over Gonsalves. However, given
13 the allowability of claim 39, these claims are allowable as depending from an
14 allowable base claim. These claims are also allowable for their own recited
15 features which, in combination with those recited in claim 39, are neither disclosed
16 nor suggested in the references of record, either singly or in combination with one
17 another.

18 **Claim 49** recites a method of displaying a multi-media editing project
19 comprising [added language appears in bold italics]:

- 20
- 21 • receiving one or more parameters from a user, the parameters being
22 associated with a multi-media editing project and relating to a
23 transition that can be applied between two video clips in the project;
- 24 • selecting a bitmap that defines a first transition that can be used to
25 transition between the video clips;
- operating upon the bitmap to provide a second transition that is
different from the first transition by using the one or more
parameters; and

- effecting the second transition between video clips,
- wherein said receiving comprises receiving parameters that define a range that, in turn, defines a border thickness of a border that is used in connection with the first-mentioned bitmap to effect the second transition, *wherein said second transition completely replaces one video with another video.*

In making out the rejection of this claim, the Office acknowledges that Gonsalves fails to clearly teach that the transitions are configured to enable one video clip to completely replace another video clip. Applicant agrees that Gonsalves neither discloses nor suggests any such subject matter. Furthermore, Gonsalves teaches directly away from the recited subject matter by disclosing a system that feathers a first and second image to create a *composite image*. The *composite image* contains features from *both* the first and the second image (see, e.g. Fig. 1 and the related discussion).

The Office mistakenly likens Gonsalves' ability to *combine* multiple different video clips to the recited subject matter which recites transitions that are configured to enable one video clip to completely replace another video clip. Applicant respectfully submits that Gonsalves neither discloses nor suggests any such thing.

The Office argues that one of skill in the art would be motivated to modify Gonsalves in this regard to provide a transition effect for displaying a complete background image, whenever desired. Yet, this is completely contrary to the disclosure and teaching of Gonsalves. Modifying Gonsalves in the manner suggested by the Office would appear to render Gonsalves unsatisfactory for its intended purpose which is to *combine* two images to create one composite image where the two images appear as though they are truly one image, as well as change

1 an important operating principle of Gonsalves. As noted in the MPEP section
2 discussed above, if the proposed modification would render the prior art invention
3 being modified unsatisfactory for its intended purpose, then there is no suggestion
4 or motivation to make the proposed modification. It appears clear to Applicant, in
5 view of the §103 standard and the guidance provided by the MPEP, which is
6 firmly rooted in established case law, that there is no support for modifying
7 Gonsalves in the manner suggested by the Office.

8 Accordingly, for at least these reasons, this claim is allowable.

9 Claims 50 and 51 stand rejected under §103 over Gonsalves. However,
10 given the allowability of claim 49, these claims are allowable as depending from
11 an allowable base claim. These claims are also allowable for their own recited
12 features which, in combination with those recited in claim 49, are neither disclosed
13 nor suggested in the references of record, either singly or in combination with one
14 another.
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Conclusion

All of the claims are in condition for allowance. Accordingly, Applicant requests a Notice of Allowability be issued forthwith. If the Office's next anticipated action is to be anything other than issuance of a Notice of Allowability, Applicant respectfully requests a telephone call for the purpose of scheduling an interview.

Respectfully Submitted,

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By: 

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